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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,781	01/05/2001	Craig S. Skinner	PALM-3551.US.P	3204

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EXAMINER
FLEMING, FRITZ M

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/755,781	SKINNER, CRAIG S.
	Examiner	Art Unit	
	Fritz M Fleming	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-11 and 13-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-11,13-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 4 and 11 and 20 contain the trademark/trade name MOBITEX. Where a

trademark or trade name is used in a claim as a limitation to identify or describe a

particular material or product, the claim does not comply with the requirements of 35

U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App.

1982). The claim scope is uncertain since the trademark or trade name cannot be used

properly to identify any particular material or product. A trademark or trade name is

used to identify a source of goods, and not the goods themselves. Thus, a trademark or

trade name does not identify or describe the goods associated with the trademark or

trade name. In the present case, the trademark/trade name is used to identify/describe

a type of communications network and, accordingly, the identification/description is

indefinite. Accordingly, the claims will be treated as requiring an access number.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

>   1.   Determining the scope and contents of the prior art.
>   2.   Ascertaining the differences between the prior art and the claims at issue.
>   3.   Resolving the level of ordinary skill in the pertinent art.

    4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

4.   Claims 1-4,6-11,13-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Moriya in view of Fingerhut.

Moriya teaches an overall automated registration and activation system of Figure 1 comprising the terminals 1, network 3 and server 2. Specifically, the terminal 1 is disclosed to be a PDA (col. 4, line 18), with it insides detailed at Figure 2. Figure 2 shows a PDA with a telephone function, such that the radio communication unit 17 (inherently comprising a transmit and receive unit per col. 5, lines 15-18 to include connection to the network 3) serves as the claimed network interface component. Note also a processor 11, which processes and controls the components in terminal 1, inherently to include the automated registration/activation, as this falls under the control of components in the terminal 1. A read only memory is judged to be that of ROM 13 (to store an operation program and the like of terminal 1 per col. 4, lines 33-39) and flash ROM 16 (to store network configuration information like telephone number of terminal 1 and service provided and a password and other information per col. 4, line 47-col. 5, line 14). A data bus is seen at interconnection bus 19.

Applicant has defined "registration and activation of the device on a network" to mean, for example, the establishing of a network account (page 4, lines 4-5). This is exactly what Moriya does per columns 6-11 and Figures 3-11. Of interest, is the first embodiment of columns 6-8 and Figures 5/6. At initial turn on, it is determined if the PDA is registered and activated by the status of the provider registration completion flag

(S12), wherein a non registered/activated PDA displays the nonregistration icon 36D

(S14) as the provider icon. Provider icon manipulation is awaited (S16), and if such

occurs on a non registered/activated PDA (S20 route A), then the automated

registration and activation sequence is started (S22+), so as to allow the user to create

a network account with a reduction of required entry matters and a facilitation of

authentication and connection to the server and network (column 1).

Per claim 2, a network unit identifier is the telephone number and terminal ID and

device kind code stored in flash ROM 16. Per claim 3, the processor 11 controls the

PDA operations and forwards the flash ROM 16 information to the network 2 and 3 at

S36 in response to user manipulation of the icon 36D. Per claim 4, the automatic

registration and activation is at the behest of the user's manipulation of icon 36D. Per

claim 6, the processor controls communications by submitting network configuration

information at S36 and receives network unit identification information at S38,40 so that

the flag is then set at S42 with additional registration and activation at S44,46. Per

claim 7, such is taught by the radio communication unit 17 inclusive of the radio public

circuit, as a radio public circuit is a cellular communication network, and the

transmission and reception of data requires a transmitter and receiver and antenna.

Per claim 8, terminal device 1 is a PDA. Claims 9-11,13,14 mirror claims 2-4,6,7 and

the same apply. The method steps of claims 15-20 are addressed above, noting also

that portions of the network configuration information is loaded by the manufacturer, per

the column 4 fixing of the terminal ID at the time of manufacturing.

Moriya lacks specific mention of automatic registration and activation upon

bootup, noting that there is an automatic check of the flag at power up, but automatic

registration and activation is at the request of the user.

Fingerhut, in the same field of automated device registration and activation,

discloses use in over the air activation of two way wireless communication devices

(column 1, lines 7-15), therefore being properly combinable with Moriya. Attention is

drawn to column 3, lines 32+ and Figure 2 in which the first step is turn on, with

automatic determination of a registered and activated state via UNA status at location 3.

If the device is not registered and activated, i.e. no UNA at 3, then the device

automatically starts the OAA process.

Therefore it would have been obvious to one having ordinary skill in the art at the time

that the invention was made to modify Moriya per the teachings of Fingerhut, so that

upon bootup/power up, a non registered/activated device automatically starts the

registration and activation process, so as to be automatic, simple, quick, and without

human intervention (Fingerhut, column 6, lines 52-63). It is to be pointed out, that the

amended limitations of claims 1 and 8 and 15 perhaps are not as limiting as applicant

has envisaged. For example, claim 1 requires that the processor "automatically

configure a device for communicating on a communication network with automated

registration and activation on said communication network when booted up", with claim

8 stating the same. Claim 15 is quite broader, as it only requires "using said

communication network configuration information to automatically configure a

communication device for communicating with a communication network when booted

up". Applicant wants to toss out the Fingerhut reference due to the fact that it mentions

on column 3, lines 47-50, that once contact with the network is established, that the

user is prompted for the information required to activate the device. However, this

passage is being referred to in a vacuum and not in proper context. For example,

further up at lines 10 and 11, mention is made that the software application stored at 13

initiates the OAA process. Further down in lines 32-58, one finds that the first step is

device power turn on (tantamount to a bootup), and once turned on (i.e. when booted),

the device 5 automatically determines that a UNA is not present in location 3 and

initiates the OAA process. Then the network is contacted. Then the user is prompted

for information required to activate the device (which per column 4, would include things

like method of payment, personal user information, level of service and an area of

desired coverage), the ARP generated and then sent out, with alternatively the user

prompting and ARP generating occurring prior to the establishing of contact with the

network. The important fact here is that the process for registration (i.e. the OAA) is

automatically started after a bootup when the UNA is not present, or in other words,

before the device is registered on the network, as a UNA is required to be assigned to

the device before the device can be activated on the network, which per column 4, lines

45-47 is again an automated process via a MOBITEX network. Thereafter, the UNA is

loaded over the air into the device 5 (bottom of column 5), which then causes the device

5 to be "BORN" and become operational and activated (top of column 6). The whole

purpose is summed up at column 6, lines 52+, where one finds that the OAA process

simplifies the activation process for the user, the device can be activated in 2 minutes,

the user does not have to fill out any forms or make any phone calls so that the "entire

OAA process is automated and requires no human intervention." This last quote is

directly from lines 61-62, and provides the teaching that applicant says Fingerhut

teaches away from. Applicant needs to re-evaluate the claims, as they only require a

very broad ability to automatically configure a communication device, without any

limitations to limit or preclude any user entry. As Fingerhut says, the OAA process is

automated and requires no human intervention, thereby meeting the breadth of the

claims. Regarding claims 4 and 11 and 20, the UNA is a unique network access on a

MOBITEX network (i.e. per column 4), and thereby represents a MOBITEX access

number.

One point needs to be raised, and that is the level of automation per applicants'

own disclosure does not indicate that the "automated" process is entirely free of user

input and interaction. For example, one finds that the automated process only frees the

user from an extensive exchange of information (page 6). One also finds that the user

is not required to engage in a complicated series of manual interactions for device

registration and activation (page 10). Page 12 reiterates that the user does not have to

engage in an extensive exchange of information. Page 13 is even more revealing, in

that it clearly states that the "automated registration and activation system 100 to

provide a good user experience with minimal required user interaction". Finally, page

19 again states that the user is not required to engage in a complicated series of

manual interactions with the device to complete registration and activation, and page 21

states that the user is not required to engage in a complicated series of manual

interactions with the device to configure or complete registration and activation. Thus a

fair reading and interpretation of applicant's own disclosure leaves one with the distinct

feeling that some user interaction is needed, and indeed required, as nowhere did the

specification state that "NO user interaction is required". It is just that the required

interaction is not very complicated or extensive, due to a process that is automated to

the point ease the process for the user. Thus it appears that the applicant's own

disclosure provides for the same capability that applicant criticized the Fingerhut

reference for....that being an automated configuration, activation and registration

process that requires the least amount of user interaction as possible. Thus applicant is

respectfully requested to re-consider the arguments submitted, in light of applicant's

disclosure which indicates that the automated process is not without user intervention.

Specifically, applicant should refer to page/line number and reference numeral in a

subsequent response in order to support any particular interpretation of the automated

process.

Response to Arguments

5.   Applicant's arguments filed 10/12/2004 have been fully considered but they are

not persuasive. They are addressed in detail above.

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz M Fleming whose telephone number is 571-272-4145. The examiner can normally be reached on M-F, 0600-1500.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-272-2100.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Fritz M Fleming
Primary Examiner
Art Unit 2182

fmf